REMARKS/ARGUMENTS

Claims 1-23 are pending in the present application. No claims were canceled; claims 1, 9, 16-19, and 23 were amended; and no claims were added. Support for the amendments may be found in the Specification on at least page 16, lines 1-9. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 101

The Office Action has rejected claims 16-22 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. This rejection is respectfully traversed.

Regarding this rejection, the Office Action states:

> Claims 16-22 of the claimed invention are directed to non-statutory subject matter. These claims are drawn to a program with instruction. A program is nonstatutory. On page 33 of the specification, Applicant has provided evidence that Applicant intends the medium to include signals, as such the claims are drawn to a form of energy. Energy is not one of the four categories of invention and therefore these claims are not statutory. Energy is not a series of steps or acts and thus is not a process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not combination of substances and therefore is not a composition of matter.

Office Action dated October 18, 2007, p. 2.

The USPTO guidelines for evaluating computer-readable medium encoded with functional descriptive material, such as a computer program, expressly states that a claim to such computer-readable medium when so encoded is statutory subject matter. USPTO, *Interim Guideline for Examination of Patent Application for Patent Subject Matter Eligibility* (26 Oct. 2005) (hereinafter "The Guideline"). The Guideline provides, in relevant part:

> "[A] claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory."

Id., p. 52.

Claim 16 is directed to a computer program product in a computer readable medium. As the Guideline provides, "a computer readable medium with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized" is statutory. Because claim 16 recites a computer program product, along with the other recited steps, claim 16 does describe a data structure that defines structural and functional interrelationships between the data structure and the computer software and hardware components, which permit the data structure's functionality to be realized. Thus, claim 16 recites patentable subject matter under 35 U.S.C. § 101, as explained under the Guideline.

Claims 17-22 depend from and further restrict claim 16 and, accordingly, also recite patentable subject matter under 35 U.S.C. § 101, as explained under the Guideline.

Thus, Applicants submit that the rejection of claims 16-22 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter has been overcome.

II. Double Patenting

The Examiner has stated that claims 1, 9, and 16 were rejected on the grounds of non-statutory obvious-type double patenting as being unpatentable over claims 1, 14, and 24 of co-pending Application No. 10/427,130. In response the Applicants have filed a Terminal Disclaimer herewith.

III. 35 U.S.C. § 103, Obviousness (Claims 1, 4-6, 8-9, 12-14, 16, 19-21, and 23)

The Office Action has rejected claims 1, 4-6, 8-9, 12-14, 16, 19-21, and 23 under 35 U.S.C. § 103 as being unpatentable over *Freivald et al.*, Checksum-Comparing Change-Detection Tool Indicating Degree and Location of Change of Internet Documents, U.S. Patent No. 6,219,818, April 17, 2001 (hereinafter "*Freivald*") in view of *Mitchell*, System and Method for Web Page Filtering, U.S. Patent No. 6,701,350, March 2, 2004 (hereinafter "*Mitchell*"). This rejection is respectfully traversed.

Regarding claim 1, the Office Action states:

> As per claim 1, Freivald discloses a method in a data processing system for marking a Web page, the method comprising:
>
> receiving a user input to mark a portion of the Web page displayed in the data processing system to form a marked portion (column 4, lines 33-36, column 7, lines 9-12, column 8, lines 6-17, Freivald teaches the user selecting (mark) portions of a Web page by highlighting a text);
>
> wherein a subsequent presentation of the Web page results in a presentation of the Web page with the marked portion (column 2, lines 50-52, column 3, lines 6-10, column 6, lines 30-32, column 11, lines 11-14, column 12, lines 65-67, column 13, lines 26-29, Freivald teaches sending the user the changed Web page or document with selected portions included to view the changes. Freivald further teaches the changed portions previously selected by the user are highlighted and sent to the user for presentation).
>
> Freivald does not explicitly disclose:
>
> storing an identifier of the marked portion in a local data structure in the data processing system.
>
> However, in an analogous art, Mitchell teaches an editor tool and filter database that maintains the URL associated with the selected portion of the web page. The filter database is stored on the filtering proxy that is situated in the user's local computer (column 3, lines 48-51, column 4, lines 1-3, 8-9).
>
> Therefore one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate Mitchell's storing an identifier of the marked portion in a local data structure in the data processing system in Freivald's method in order to generate filtered URL data and apply filtering associated with the

URL is so any identified section is not displayed on the Web page (Mitchell, column 3, lines 50-52, column 4, lines 15-16).

Office Action dated October 18, 2007, pp. 5-6.

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka,* 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In determining obviousness, the scope and content of the prior art are... determined; differences between the prior art and the claims at issue are... ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). "Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *KSR Int'l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). "*Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.* Id. (citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006))."

Amended claim 1, which is representative of claims 9, 16, and 23, with regards to similarly recited materials, recites:

> 1. A method in a data processing system for marking a Web page, the method comprising:
>
> receiving a user input to mark a portion of the Web page displayed in the data processing system to form a marked portion;
>
> storing an identifier of the marked portion in a local data structure in the data processing system, wherein a subsequent presentation of the Web page results in a presentation of the Web page with the marked portion; and
>
> jumping to the marked portion of the Web page in response to an input from the user.

Specifically, both *Freivald* and *Mitchell*, either alone or in combination, fail to teach or suggest the feature of "jumping to the marked portion of the Web page in response to an input from the user." The Office Action does not cite to any portion of *Freivald* as allegedly teaching or suggesting this feature, nor does any portion of *Freivald* teach or suggest this feature.

Freivald is directed towards a method for tracking changes to portions of Web pages. According to *Freivald*, a user registers a web-page document by submitting his e-mail address and the uniform resource locator (URL) of the desired document. The document is fetched and the user can select text on

the page of interest. The document is divided into sections bounded by hypertext markup-language (HTML) tags. A checksum is generated and stored for each HTML-bound section. Only checksums are stored. A change-detection web server automatically checks web-page documents for recent changes. The server retrieves and compares documents one or more times a week. During periodic comparisons, a fresh copy of the document is retrieved, divided into HTML-bound sections and checksums generated for each section. The freshly-generated checksums are compared to the archived checksums. Sections with non-matching checksums are highlighted as changed, and the percentage of changed sections is reported. The user-defined selection is also stored as a checksum and compared to a freshly-generated checksum. Changed checksums outside the user-defined selection do not generate a change notification. (See *Freivald*, Abstract) When the user is notified of the changed portions, either the entire document can sent to the user or just the portions with the changes can be sent. Further, the changed sections, though not specifically the changes, can be highlighted. (See *Freivald*, column 6, lines 27-32; column 12, lines65 – column 13, line 28). Nowhere does *Freivald* teach the feature of "jumping to the marked portion of the Web page in response to an input from the user."

Additionally, as *Freivald* teaches that only the changed portions of the document are sent to the user, there is no need for a user to jump to anywhere within the document, thus, *Freivald* also fails to suggest the feature of "jumping to the marked portion of the Web page in response to an input from the user." Therefore, Applicants submit that *Freivald* fails to teach or suggest the feature of "jumping to the marked portion of the Web page in response to an input from the user."

Mitchell fails to cure the deficiencies of *Freivald*. *Mitchell* fails to teach or suggest the feature missing from *Freivald*, the feature of "jumping to the marked portion of the Web page in response to an input from the user." The Office Action does not cite to any portion of *Mitchell* as allegedly teaching or suggesting this feature, nor does any portion of *Mitchell* teach or suggest this feature.

Mitchell is directed to a method for selectively filtering out sections of Web pages. A user identifies a section or a geometric area of the Web page to be suppressed on subsequent visits. When an item is selected for suppression, a filter script is generated to remove the unwanted Web page area. The filter script is stored and associated with the URL of the Web page. Whenever the Web page associated with the URL is subsequently accessed by the user, the filter script, which maps to that URL, is applied to the Web page and suppresses the identified section. *Mitchell* fails to teach the feature of "jumping to the marked portion of the Web page in response to an input from the user." Further, as *Mitchell* teaches suppressing user selected portion of Web pages, there would be no reason for *Mitchell* to jump to the suppressed sections, as they are no longer displayed. Thus, *Mitchell* also fails to even suggest the feature of "jumping to the marked portion of the Web page in response to an input from the user."

Furthermore, as both *Freivald* and *Mitchell* teach away from the presently claimed feature of "jumping to the marked portion of the Web page in response to an input from the user," no reason exists to combine the references or amend either reference to reach the presently claimed invention. Both *Freivald* and *Mitchell* provide other means than "jumping to the marked portion of the Web page in response to an input from the user" to focus the user's attention to the relevant portions of the Web page. *Freivald* teaches that only the changed portions of the document are sent to the user. Thus, as taught by *Freivald*, there is no need for a user to jump to anywhere within the document. *Mitchell* teaches suppressing user selected portion of Web pages. Therefore, as taught by *Mitchell*, there would be no reason for a user to jump to the suppressed sections, as they are no longer displayed. Thus, both *Freivald* and *Mitchell* teach away from the claimed feature of "jumping to the marked portion of the Web page in response to an input from the user." Therefore, no reason exist to combine or amend the references to reach the presently claimed invention.

Therefore, for at least the reasons set forth above, Applicants submit that *Freivald* and *Mitchell*, whether alone or in combination, fail to render claim 1 obvious, as *Freivald* and *Mitchell*, either alone or in combination, fail to teach or suggest all the features of claim 1. Further, as claim 1 is representative of claims 9, 16, and 23, the same distinctions between claim 1 and the combination of *Freivald* in view of *Mitchell* apply to claims 9, 16, and 23. Thus, Applicants submit that claims 1, 9, 16, and 23 are in condition for allowance over the cited combination of *Freivald* in view of *Mitchell*. Further, as claims 4-6, 8, 12-14, and 19-21 depend from claims 1, 9, and 16, Applicants submit that claims 4-6, 8, 12-14, and 19-21 are also in condition for allowance over the combination of *Freivald* in view of *Mitchell* at least by virtue of their depending from an allowable base claim.

Therefore, the rejection of claims 1, 4-6, 8-9, 12-14, 16, 19-21, and 23 under 35 U.S.C. § 103 has been overcome.

IV. 35 U.S.C. § 103, Obviousness (Claims 2, 10, and 17)

The Office Action has rejected claims 2, 10, and 17 under 35 U.S.C. § 103 as being unpatentable over *Freivald* in view of *Mitchell* and further in view of (missing from Office Action). This rejection is respectfully traversed.

The Office Action seems to indicate that the Examiner intended to indicate a an additional reference in rejecting these claims. However no additional reference was given or cited. Therefore, Applicants have attempted to respond to the rejection as best as could be understood and have interpreted the intended missing reference as being equivalent to eh Examiner's Official Notice.

Regarding claim 2, the Office Action states:

As per claim 2, Freivald does not explicitly discloses the method of claim 1, wherein the Web page is a first Web page and further comprising:

responsive to receiving a second Web page, determining whether an entry corresponding to the second Web page is present in the local data structure;

responsive to the entry being present, presenting the second Web page with at least one marked portion using the entry in the local data structure.

However, in an analogous art, Mitchell teaches associated web pages of a particular URL are filtered for the specified unwanted portion. The unwanted portion is marked by the user so that it is deleted in subsequent viewing of the web page or associated web pages. For example, Mitchell teaches a specific URL such as www.hello.com being requested by the user for filtering. Other related URLs associated such as www.hello.com/users.html or www.hello.com/index.html are also stored and filtered for the unwanted portion. This teaches receiving a second web page that is present in the local data structure. Since the marked portion is removed and not seen in subsequent viewing of the web page and its associated web pages, the presentation of the associated web pages are presented with the marked portion stored in the local data structure because the marked portion is the deleted or unwanted portion specified by the user (column 4, lines 30-45).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate Mitchell's Web page is part of a Web site and wherein the web site is defined in a Web page index table data structure having records for each Web page of the Web site, and each Web page of the Web site is defined in a Web page table data structure having records identifying tags that identify portions of associated Web pages in Freivald's method in order that filters can be applied to one or more related URLs (Mitchell, column 4, lines 39-40).

Office Action dated October 18, 2007, pp. 16-17 (emphasis in original).

Claims 2, 10, and 17 depend from independent claims 1, 9, and 16. As explained above in Section II, the combination of *Freivald* in view of *Mitchell* fails to teach or suggest all the features of claims 1, 9, 16, and 23. Nothing in the Examiner's Official Notice cures the deficiencies of *Freivald* in view of *Mitchell*. The Examiner's Official Notice merely explains how the Examiner equates portions of *Mitchell* to the features recited in claims 2, 10, and 17. Thus, the Examiner's Official Notice fails to teach or suggest the features missing from the combination of *Freivald* in view of *Mitchell*, the feature of "jumping to the marked portion of the Web page in response to an input from the user."

Therefore, Applicants submit that claims 1, 9, 16, and 23 are allowable over the combination of *Freivald* in view of *Mitchell* and further in view of the Examiner's Official Notice. Further, as claims 2, 10, and 17 depend from claims 1, 9, and 16, Applicants submit that claims 2, 10, and 17 are also in condition for allowance, at least by their virtue of depending from allowable claim.

Therefore, the rejection of claims 2, 10, and 17 under 35 U.S.C. § 103 has been overcome.

V. 35 U.S.C. § 103, Obviousness (Claims 3, 11, and 18)

The Office Action has rejected claims 3, 11 and 18 under 35 U.S.C. § 103 as being unpatentable over *Freivald* in view of *Mitchell* and further in view of *Beran et al.*, Method and Apparatus for

Synchronization of Text and Audio Data, U.S. Patent No. 6,961,895, November 1, 2005 (hereinafter "*Beran*"). This rejection is respectfully traversed.

Regarding claim 3, the Office Action states:

> As per claim 3, Freivald, in view of Mitchell, does not explicitly discloses the method of claim 2, wherein the presenting step comprises:
>
> using speech synthesis to read the marked portion.
>
> However, in an analogous art, Beran teaches a human narrator reading a selected section of text to form an audio data portion for the selected text (column 2, lines 32-36, column 3, lines 1-10, column 6, lines 1-8).
>
> Therefore, one of ordinary skill in the art would have found it obvious to implement or incorporate Beran's speech synthesis to read the marked portion in Freivald's method in order to produce talking books for blind an dyslexic users (Beran, column 1, lines 64-67, column 6, lines 57-60).

Office Action dated October 18, 2007, p. 20.

Claims 3, 11, and 18 depend from independent claims 1, 9, and 16. As explained above in Section II, the combination of *Freivald* in view of *Mitchell* fails to teach or suggest all the features of claims 1, 9, 16, and 23. *Beran* fails to cure the deficiencies of the combination of *Freivald* in view of *Mitchell*. *Beran* fails to teach or suggest the feature missing from *Freivald* in view of *Mitchell*, the feature of "jumping to the marked portion of the Web page in response to an input from the user." *Beran* is directed to synchronizing recorded audio narration of a section of text with the display of the recorded portion of text. No portion of *Beran* teaches marking a user selected portion of a Web page or "jumping to the marked portion of the Web page in response to an input from the user." Thus, *Beran* fails to teach the feature of "jumping to the marked portion of the Web page in response to an input from the user." Furthermore, as *Beran* is silent in regards marking a user selected portion of a Web page or "jumping to the marked portion of the Web page in response to an input from the user," *Beran* also fails to even suggest the feature of "jumping to the marked portion of the Web page in response to an input from the user."

Thus, Applicants submit that *Beran* fails to cure the deficiencies of *Freivald* in *Mitchell* in that *Beran* fails to teach or suggest the feature of "jumping to the marked portion of the Web page in response to an input from the user."

Therefore, Applicants submit that claims 1, 9, 16, and 23 are allowable over the combination of *Freivald* in view of *Mitchell* and further in view of *Beran*. Further, as claims 3, 11, and 18 depend from claims 1, 9, and 16, Applicants submit that claims 3, 11, and 18 are also in condition for allowance, at least by their virtue of depending from allowable claim.

Furthermore, *Beran* does not teach or suggest the features of claims 3, 11, and 18. Claims 3, 11, and 18 recite the feature of "using speech synthesis to read the marked portion." *Beran* does not teach or suggest this feature. Rather, *Beran* teaches that one or more human narrators read and record portions of

existing text data and then synchronizing that recorded reading with the text data. Applicants respectfully submit that recording a human reading a portion of text and then playing it back is not the same as "using speech synthesis to read the marked portion." As taught by *Beran*, a user can only hear the text if someone has already read and recorded that portion text selected by the user. Whereas, as taught by the present invention, a user can go to any website and the speech synthesizer will simply read the selected text for the user when the user selects it, without any need for a prerecorded version to exist. Additionally, as taught by *Beran*, the audio files are broken up into specific portions. Therefore, a user cannot simply pick any section and have that section read to them. Rather, the user must hear the recording from wherever the beginning of the recorded section is, instead of from wherever the user selects.

Therefore, the rejection of claims 3, 11 and 18 under 35 U.S.C. § 103 has been overcome.

VI. 35 U.S.C. § 103, Obviousness (Claims 7, 15 and 22)

The Office Action has rejected claims 7, 15, and 22 under 35 U.S.C. § 103 as being unpatentable over *Freivald* in view of *Mitchell* and further in view of *Bargeron et al.*, Robust Anchoring of Annotations to Content, U.S. Patent Publication No. 2006/0080598, April 13, 2006 (hereinafter "*Bargeron*"). This rejection is respectfully traversed.

Regarding claim 7, the Office Action states:

> As per claim 7, Freivald, in view of Mitchell, does not explicitly discloses the method of claim 1, wherein the marked portion is marked using at least one of a different text color, and a different text size.
>
> However, in an analogous art, Bargeron teaches indicating highlighted portions of text in a variety of ways such as changing the color or font of the highlighted text (paragraph [0020]).
>
> Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to incorporate or implement Bargeron's marked portion is marked using at least one of a different text color, and a different text size in Freivald's method in order to identify the frequency of the highlighted text (Bargeron, paragraphs [0026-00271).

Office Action dated October 18, 2007, p. 22.

Claims 7, 15, and 22 depend from independent claims 1, 9, and 16. As explained above in Section II, the combination of *Freivald* in view of *Mitchell* fails to teach or suggest all the features of claims 1, 9, 16, and 23. *Bargeron* fails to cure the deficiencies of the combination of *Freivald* in view of *Mitchell*. *Bargeron* fails to teach or suggest the feature missing from *Freivald* in view of *Mitchell*, the feature of "jumping to the marked portion of the Web page in response to an input from the user." *Bargeron* is directed to robustly anchoring annotations to the annotated text. No portion of *Bargeron* teaches, "jumping to the marked portion of the Web page in response to an input from the user." Thus,

Bargeron fails to teach the feature of "jumping to the marked portion of the Web page in response to an input from the user." Furthermore, as *Bargeron* is silent in regards to "jumping to the marked portion of the Web page in response to an input from the user," *Bargeron* also fails to even suggest the feature of "jumping to the marked portion of the Web page in response to an input from the user."

Thus, Applicants submit that *Bargeron* fails to cure the deficiencies of *Freivald* in *Mitchell* in that *Bargeron* fails to teach or suggest the feature of "jumping to the marked portion of the Web page in response to an input from the user."

Therefore, Applicants submit that claims 1, 9, 16, and 23 are allowable over the combination of *Freivald* in view of *Mitchell* and further in view of *Bargeron*. Further, as claims 3, 11, and 18 depend from claims 1, 9, and 16, Applicants submit that claims 3, 11, and 18 are also in condition for allowance, at least by their virtue of depending from allowable claim.

Therefore, the rejection of claims 7, 15, and 22 under 35 U.S.C. § 103 has been overcome.

VII. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: January 18, 2008

Respectfully submitted,

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